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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/21/99 12/30/99 FILED

17901 175-450

020582
PENNY AND EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK NY 10006-2711

HMP271230

EXAMINER

ART UNIT	PAPER NUMBER
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1456
DATE MAILED:

8

12/30/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/220,142

Applicant(s)

Friend et al.

Examiner

Ardin Marschel

Group Art Unit

1655



X Responsive to communication(s) filed on Oct 5, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

X Claim(s) 1-88 is/are pending in the application.

Of the above, claim(s) 51-57, 65-71, and 79-88 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

X Claim(s) 1-50, 58-64, and 72-78 is/are rejected.

Claim(s) _____ is/are objected to.

X Claims 1-88 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

X Information Disclosure Statement(s), PTO-1449, ~~Page No(s)~~ (8 sheets)

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Applicants' election with traverse of Group I and Specie B (claims 1-50, 53-64, and 72-78) in Paper No. 6, filed 10/5/99, is acknowledged. The traversal is on the ground(s) that searching all of the instant claim embodiments, and thus all instant claims, would not be a serious search burden. This is not found persuasive because it does not argue or even suggest why the basis for the restriction with specie election set forth in the action, mailed 8/9/99, is not proper. In the absence of this argument the basis for the restriction with specie election is still deemed proper. Additionally, regarding the serious search burden to search all of the groups and species together this is non-persuasive because the different characteristics as summarized in said office action would require separate consideration and search. It is also noted that the drug evaluation industry is enormous and thus searching multiple aspects of the literature is a serious addition over singular aspects of the industry. Therefore the searching of the groups and species together compared to separately is clearly different and burdensome.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 1-50, 58-64, and 72-78 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fodor et al. (P/N 5,800,992).

Arrays are utilized in Fodor et al. to perform hybridization assays simultaneously over numerous hybridization probe sequences as summarized throughout the disclosure. The usage of these arrays for drug evaluation is motivated and suggested in column 60, lines 44-50. These arrays can be utilized for determining the expression of a multitude of mRNA types as summarized in column 35, line 12, through column 36, line 40.

Thus, it would have been obvious to someone of ordinary skill in the art at the time of the instant invention to practice the instant invention because Fodor et al. suggests and motivates drug evaluation as an option regarding expression arrays of the

reference thus resulting in the practice of the instant invention.

No claim is allowed.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 23, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

December 29, 1999

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER